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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/755,583 | 01/12/2004 | Jeffrey Kozak | 4002-3420 | 9189 |
| 30565 | 7590 | 08/11/2004 | EXAMINER | |
| WOODARD, EMHARDT, MORIARTY, MCNETT & HENRY LLP | | | RAMANA, ANURADHA | |
| BANK ONE CENTER/TOWER | | | ART UNIT | PAPER NUMBER |
| 111 MONUMENT CIRCLE, SUITE 3700 | | | 3732 | |
| INDIANAPOLIS, IN 46204-5137 | | | | |

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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| | | |
|------------------------------|-----------------|--------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/755,583 | KOZAK ET AL. |
| | Examiner | Art Unit |
| | Anu Ramana | 3732 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 12 January 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 13-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 13-21 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 12 January 2004 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date 1/12/2004.
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: Attachment A

DETAILED ACTION

The preliminary amendment filed on January 12, 2004 has been entered. Accordingly, claims 13-21 are now pending in the instant application and have been examined in this office action.

Specification

The disclosure is objected to because of the following informalities. On page 5, line 14, “angle (B)” should be “angle (D)” to be consistent with the drawings. Appropriate correction is required.

The specification is objected to as failing to provide proper antecedent basis for the subject matter of claims 16 and 18, namely “compressing fusion material in said intervertebral space,” “engaging fusion material by the inferior end plate and superior end plate”, and “compressing fusion material between said end plates,” respectively. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction is required.

Claim Objections

Claim 19 is objected to because of the following informalities. In line 2, “devices” should be “means” for clarity and consistency with the specification. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 14, lines 2-3, it is unclear what configuration is being claimed by the phrase “on convergent paths in S1.” Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 13-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fraser (US 6,432,106).

Fraser discloses an anterior spinal fixation assembly having a plate 20 with a foot portion and screws 46 and 48 wherein screws 46 are installed through holes in the upper portion of the plate into an upper vertebra and screws 48 are installed downwardly through the foot portion into an underlying adjacent vertebra to compress a fusion cage with fusion promoting material between the adjacent vertebra (Figs. 3 and 8, col. 1, lines 36-49, col. 2, lines 20-67, col. 3, lines 1-36 and col. 4, lines 38-43). Also, see Attachment A for a marked up version of Figure 3.

Fraser discloses the claimed invention except for the specific type of adjacent vertebrae, namely L5 and S1. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have placed the Fraser assembly between L5 and S1 vertebrae, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 7.

Regarding claims 19-21, Fraser discloses that screws 46 and 48 are a "locking type" so that they cannot back out of the plate holes (col. 3, lines 19-20).

The method steps of claims 13-21 are performed by the Fraser spinal fixation assembly when the assembly is utilized to promote fusion between adjacent vertebrae such as the L5 and S1 vertebrae.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject

matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 13-21 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 13-21 of copending Application No. 10/843,110. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Conclusion

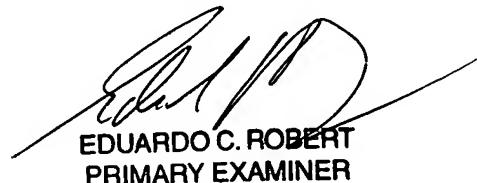
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (703) 306-4035. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached at (703) 308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

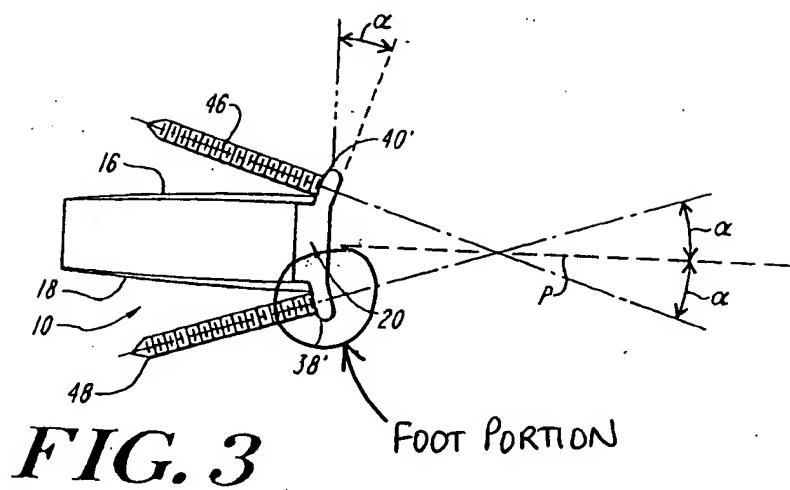
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AR *Anuadha Ramana*
August 9, 2004



EDUARDO C. ROBERT
PRIMARY EXAMINER

ATTACHMENT A

**FIG. 3**